

RECEIVED
CENTRAL FAX CENTER

MAY 31 2006



The Gates Corporation
1551 Wewatta Street
Denver, CO 80202

FAX COVER SHEET

Date: 5/31/2006

TO: Examiner V. Johnson FAX: 571-273-8300

From: Jerry L. Mahurin Phone: (303) 744-5796
Patent Counsel Fax: (303) 744-4653

Number of pages including cover sheet: 8

SERIAL NO.: 10/664,443

DOCKET NO.: T02-062A

FILED: SEPTEMBER 19, 2003

TITLE: BELT TENSIONER

RESPONSE TO: AMENDMENT FILED APRIL 5, 2006

ATTACHMENTS INCLUDE: TRANSMITTAL OF DECLARATION
UNDER 37 CFR § 1.132 - 4 PAGES

DECLARATION UNDER 37 CFR § 1.132
- 3 PAGES

PLEASE NOTE: The Information contained in this facsimile is privileged and confidential and is intended only for the use of the individual named above and others who have been specifically authorized to receive it. If the one receiving it is not the intended recipient, you are hereby notified that any dissemination, distribution or copy of this communication is strictly prohibited. Thank you.

RECEIVED
CENTRAL FAX CENTER

MAY 31 2006

I hereby certify that this correspondence is
being filed by fax Transmission to
(571)273-8300, Commissioner Of Patents,
Alexandria VA 22313-1450 on

May 31, 2006
For: The Gates Corporation,
Signature Sonia L. Talley
Date signed: May 31, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
SERKH, Alexander

Serial No.: 10/664,443

Docket No.: T02-062A

For: BELT TENSIONER

)
)
) Examiner: Johnson, Vicky A.
)
) Group Art Unit: 3682
)
)
)

Via Fax: (571)273-8300
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

TRANSMITTAL OF DECLARATION UNDER 37 CFR § 1.132

Applicant respectfully requests that the Examiner enter the enclosed Declaration under 37 CFR §1.132 of Michael B. Schmid, the sole Inventor of cited reference U.S. Pat. No. 6,039,664 (hereinafter, *Schmid*). This Declaration is presented in furtherance of the Amendment filed April 5, 2006 in the above-identified matter.

As noted in the April 5, 2006 Amendment, claims 1-3 and 5-11 stand rejected as anticipated by *Schmid*. It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102

with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejections of record do not satisfy one or more of these requirements. In the rejection of independent claim 1 the Office Action parenthetically states:

It is inherent that the forces of the strut would balance out the forces of the pulley, because as the belt applies more force against the pulley the strut would apply an equal opposite force in order to keep tension on the belt. The forces of the pulley and the strut have to pass through the pivot bearing and balance in order to keep the appropriate tension on the belt (emphasis added).

As pointed out in M.P.E.P. § 2112(IV), to establish inherency "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). M.P.E.P. § 2112.01(I) provides that "the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product." *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

Independent claim 1 recites "said pulley and said attachment point laterally offset in relation to said pivot bearing and substantially balanced in terms of parasitic torque across said pivot bearing" (emphasis added). Assuming *ad arguendo* that, as the Examiner alleges, That the forces of the pulley and the strut of *Schmid* "have to pass through the pivot bearing and balance in order to keep the appropriate tension on the belt," Applicant respectfully contends that *Schmid* does not teach a pulley and attachment point being substantially balanced in terms of parasitic torque across a pivot bearing as recited by claim 1. Although, the forces to keep tension on the belt in *Schmid* may pass through bolt 10 and accompanying axel (bearing) 6 to engine block 4, nothing in *Schmid* would suggest that the pulley and attachment point are substantially balanced in terms of parasitic torque across axel 6.

Further, Applicant presents the accompanying Declaration under 37 C.F.R. §1.132 by Michael B. Schmid, the sole inventor of the *Schmid* reference, as further rebuttal evidence under M.P.E.P. § 2112.01(I). Therein, beginning on page 2, Mr. Schmid points out:

my patent was not intended to teach or suggest, nor I do not believe one of ordinary skill in the art would find that, the tensioner arrangement of my patent would necessarily possess the characteristic of being substantially balanced in terms of parasitic torque across its pivot bearing(s). More specifically, my patent does not teach or suggest balancing a pulley, attachment point and pivot bearing in terms of parasitic torque across the pivot bearing by arranging the a pulley, attachment point and pivot bearing such that a balance line that might be inferred as passing through the through an axis of the strut attachment point and a center of the tensioner pulley would intersect the pivot shaft. Such an implementation of the invention of claim 1 is taught as a means to balance the a pulley, strut attachment point and pivot bearing in terms of parasitic torque by the specification of patent application serial number 10/664,443. Review of Figure 1 of my patent makes clear that a balance line cannot pass through the axis of the strut attachment point, a center of the tensioner pulley and the pivot shaft of my patent, as the a plane containing the pulley axis and the pivot axis is perpendicular to a plane containing the pivot axis and the attachment point. As pointed out in the specification of patent application serial number 10/664,443 the attachment point for the strut of my patent remains substantially in the plane at the center of rotation of the pivot bearing. It is readily apparent that, when the tensioner of my patent is placed into operation, the forces acting upon the tensioner by the belt and the strut give rise to an unbalanced load across the pivot bearing causing parasitic torque, which tends to force the pivot shaft to axially misalign with the bearing. This would be true whether the strut is providing the biasing force for the tensioner or only modifying the biasing force through damping. Thus, my patent does not teach or suggest, nor does my patent necessarily possess the characteristic of balancing a pulley, strut attachment point and pivot bearing in terms of parasitic torque across the pivot bearing.

For at least these reasons, Applicant again respectfully asserts that *Schmid* fails to teach at least "said pulley and said attachment point ... substantially balanced in terms of parasitic torque across said pivot bearing," as recited by independent claim 1. Therefore, independent claim 1 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between the claim 1 and the prior art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious. For example, *Schmid* is silent concerning parasitic torque, much less substantially balancing a pulley and attachment in terms of parasitic torque across a pivot bearing.

Claims 2, 3 and 5-11 ultimately depend from base independent claim 1, and thereby, each of dependent claims 2, 3 and 5-11 inherit all elements of independent claim 1. Therefore,

each of claims 2, 3 and 5-11 set forth features and limitations not recited by *Schmid*. Thus, Applicant respectfully asserts that for at least the reasons advanced above in addressing the anticipation rejection of independent claim 1, claims 2, 3 and 5-11 are also patentable over the 35 U.S.C. § 102 rejections of record.

Applicant appreciates the Examiner's consideration of the Accompanying Declaration and the further arguments presented above. For the reasons given above and those provided in the Amendment filed on April 5, 2006, particularly as reinforced by the Declarations under 37 C.F.R. §1.132 of Alexander Serkh and Michael Schmid, Applicant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. § 102 and that the application is in condition for allowance.

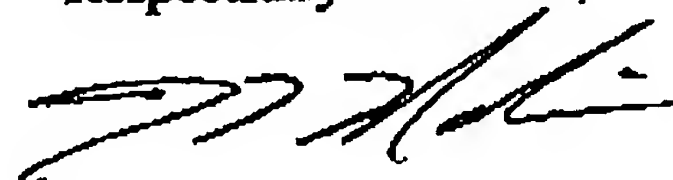
Applicant believes no fee beyond those previously paid for the Petition to Revive and RCE filed with the April 5, 2006 Amendment are required in this case. However, if a further fee is due, please charge Deposit Account No. 07-0475, from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner or other Office personnel call the below listed attorney if they believe he can be helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

Dated: May 31, 2006

JLM
Denver, Colorado

Respectfully submitted,



Jerry L. Mahurin
Attorney for the Applicant
Reg. No. 34,661
The Gates Corporation
IP Law Department 10-A3
1551 Wewatta Street
Denver, CO 80202
(303) 744-5796